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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,029	11/06/2001	Zvi Barak	BARAK-003	7739
36822	7590	06/04/2004	EXAMINER	
GORDON & JACOBSON, P.C. 65 WOODS END ROAD STAMFORD, CT 06905			PHAN, HUY Q	
			ART UNIT	PAPER NUMBER
			2685	2
DATE MAILED: 06/04/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,029

Applicant(s)

BARAK, ZVI

Examiner

Huy Q Phan

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-9 and 12-21 is/are rejected.
7) ☒ Claim(s) 10 and 11 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 14, 15, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "and/or" is not clear. The examiner suggests that "and/or" should be changed to either -- and -- or -- or- --.

For examining purpose, the examiner assumes that "and/or" has been changed to - and- --.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 7, 12, 15, 16, 18, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Houde et al. (US-5,978,678).

Regarding claim 1, Houde et al. disclose in figure 1, a method for providing cellular telephone service in the U.S. (second country) to and from outside the U.S. (first country), said method comprising:

a) bringing into the U.S. (second country) a phone (16(1)) programmed with one of a plurality of U.S. cell phone numbers which were obtained in bulk (col. 4^f, lines 14-27);

b) providing dedicated switching equipment in the U.S. (second country) (fig. 1, box 34 and col. 3, lines 40-67); and

c) routing all international calls from the phone brought into the U.S. (second country) through the dedicated switching equipment (col. 4, lines 52-67).

Regarding claim 2, Houde et al. disclose a method as recited in the rejection of claim 1, further comprising:

d) routing all domestic calls to/from the phone brought into the U.S. (second country) through the existing U.S. cell phone network (col. 4, lines 52-67).

Regarding claim 6, Houde et al. disclose a method as recited in the rejection of claim 1, further comprising:

d) notifying the dedicated switching equipment when the phone is brought into the U.S. (second country) (col. 2, lines 21-55).

Regarding claim 7, Houde et al. disclose a method as recited in the rejection of claim 6, further comprising:

e) notifying the dedicated switching equipment when the phone is taken out of the U.S. (second country) (col. 2, lines 21-55 and col. 4, line 27-col. 6, line 53).

Regarding claim 12, Houde et al. disclose a method as recited in the rejection of claim 1, further comprising:

d) obtaining the plurality of U.S. cell phone numbers in bulk (col. 2, lines 33-55).

Regarding claim 15, Houde et al. disclose in figure 1, an apparatus (16(1)) for providing cellular telephone service in the U.S. (second country) to and from outside the U.S. (first country), said apparatus comprising:

a) a cellular phone (16(1)) programmed with one of a plurality of U.S. cell phone numbers (col. 4, lines 14-27) which were purchased in bulk;

b) dedicated switching equipment in the U.S. (fig. 1, box 34 and col. 3, line 40-col. 4, line 67); and

c) means for routing all international calls to/from the phoned brought into the U.S. through the dedicated switching equipment (col. 4, lines 52-67).

Regarding claim 16, Houde et al. disclose an apparatus as recited in the rejection of claim 15, further comprising:

d) means for routing all domestic calls to/from the cellular phone through the existing U.S. cell phone network (col. 4, lines 52-67).

Regarding claim 18, Houde et al. disclose in figure 1, a method for providing cellular telephone service in the U.S. (second country) to and from outside the U.S. (first country), said method comprising:

a) providing a dedicated switch (34) in the U.S. (second country) for carrying calls to outside the U.S. (first country) (fig. 1, box 34 and col. 3, line 40-col. 4, line 67);
and

b) providing a cell phone pre-programmed to direct all international calls through the dedicated switch (col. 6, lines 5-60).

Regarding claim 19, Houde et al. disclose in figure 1, a method for providing cellular telephone service in the U.S. (second country) to and from outside the U.S. (first country), said method comprising:

a) providing a dedicated switch in the U.S. for carrying calls to outside the U.S. (fig. 1, box 34 and col. 3, line 40-col. 4, line 67);

b) providing a cell phone with a U.S. phone number (col. 2, lines 21-55 and col. 4, lines 14-27);

c) automatically routing all international from the cell phone through the dedicated switch (col. 3, line 40-col. 4, line 67); and

d) automatically routing all domestic calls to/from the cell phone through the U.S. cell phone network (col. 3, line 40-col. 4, line 67).

Regarding claim 20, Houde et al. disclose in figure 1, a method for providing international cellular telephone service in the U.S. (second country), said method comprising:

a) providing a cell phone with a U.S. phone number (col. 2, lines 21-55 and col. 4, lines 14-27); and

b) receiving at the cell phone with the U.S. phone number a call destined for a cell phone with a non-U.S. number (col. 3, line 40-col. 4, line 67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houde et al.

Regarding claim 4, Houde et al. disclose a method as recited in the rejection of claim 1. But, Houde et al. do not particularly disclose wherein: said step of routing includes routing all calls to numbers that start with zero. However, the examiner takes official notice that it is well known in the art for a switching equipment to rout all calls to

Art Unit: 2685

numbers that start with any desired digit. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically having said step of routing includes routing all calls to numbers that start with zero for purpose of making the call process faster and more reliable in order to improve the quality of the wireless communications service.

Regarding claim 13, Houde et al. disclose a method as recited in the rejection of claim 1. But, Houde et al. do not particularly disclose wherein: said phone is a part of a bulk purchase of phones. However, the examiner takes official notice that it is well known in the art for a wireless telecommunication system to serve a large number of phones. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically having said phone being a part of a bulk purchase of phones for purpose of offering the wireless telecommunication system of capability to serve a large number of cellular telephone users in order to increase the profitability.

Regarding claim 21, Houde et al. disclose a method as recited in the rejection of claim 20. But, Houde et al. fail to expressly show wherein: said providing includes renting the cell phone to a traveler to the U.S. from a foreign country. However, the examiner takes official notice that it is well known in the art for renting the cell phone to a traveler to one country from another country. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method

of Houde et al. by specifically renting the cell phone to a traveler to the U.S. from a foreign country for purpose of offering the traveler to use the cell phone with the most economical method.

5. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houde et al. in view of Seiderman (US-5,850,599).

Regarding claim 3, Houde et al. disclose a method as recited in the rejection of claim 1. But, Houde et al. do not particularly disclose wherein: said step of routing includes programming the phone to speed dial the dedicated switching equipment.

However in analogous art, Seiderman teaches wherein: said step of routing includes programming the phone to speed dial the dedicated switching equipment (col. 10, lines 18-50). Since, Houde et al. and Seiderman are related to portable cellular telephone; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically having step of routing includes programming the phone to speed dial the dedicated switching equipment as taught by Seiderman for purpose of speeding up the call process in order to improve the quality and reliability of portable cellular telephone.

Regarding claim 5, Houde et al. disclose a method as recited in the rejection of claim 1. But, Houde et al. fail to expressly show the method further comprising: d) creating billing information based on Caller ID data acquired at the dedicated switching equipment. However, Seiderman teaches creating billing information based on Caller ID

Art Unit: 2685

data acquired at the dedicated switching equipment (col. 10, lines 54-67). Since, Houde et al. and Seiderman are related to wireless telecommunication service; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically creating billing information based on Caller ID data acquired at the dedicated switching equipment as taught by Seiderman for purpose of speeding up the billing process in order to improve the quality and reliability of wireless telecommunication service.

6. Claims 8, 9, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houde et al. in view of Huotari (US-6,341,221).

Regarding claim 8, Houde et al. disclose a method as recited in the rejection of claim 1. Houde et al. disclose the method further comprising: d) associating a non-U.S. telephone number with the phone number of the phone brought into the U.S. (col. 2, lines 22-55 and col. 4, lines 14-27). But, Houde et al. do not particularly show the method comprising: e) forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S.

However in analogous art, Huotari teaches forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S. (col. 4, lines 52-64). Since, Houde et al. and Huotari are related to wireless telecommunication service; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S.

as taught by Huotari for purpose of enhancing the quality of wireless telecommunication service.

Regarding claim 9, Houde et al. and Huotari disclose a method as recited in the rejection of claim 8. Huotari teaches the method further comprising:

f) providing dedicated switching equipment outside the U.S., wherein said step of forwarding includes routing calls through the dedicated switching equipment (fig. 1, box SCP and col. 4, lines 52-64) outside the U.S.

Regarding claim 14, Houde et al. disclose in figure 1, a method of providing cellular telephone service in the U.S. to and from outside the U.S., said method comprising:

a) providing a cellular telephone (16(1)) to a traveler from outside the U.S. (second country), the cellular telephone programmed with a U.S. cell phone number (col. 2, lines 21-55 and col. 4, lines 14-27); and

b) calling a dedicated switch (34) in the U.S. (second country), said switch adapted to communicate with a telephone company outside the U.S. (first country).

But, Houde et al. do not particularly show said switch adapted to communicate with a telephone company outside the U.S. (first country) to effect forwarding of telephone calls from a non-U.S. telephone number to the U.S. cell phone number.

However, Huotari teaches forwarding of telephone calls from a non-U.S. telephone number to the U.S. cell phone number (col. 4, lines 52-64). Since, Houde et

Art Unit: 2685

al. and Huotari are related to wireless telecommunication service; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Houde et al. by specifically forwarding of telephone calls from a non-U.S. telephone number to the U.S. cell phone number as taught by Huotari for purpose of enhancing the quality of wireless telecommunication service.

Regarding claim 17, Houde et al. disclose an apparatus as recited in the rejection of claim 15. Houde et al. disclose the apparatus further comprising: d) means for associating a non-U.S. telephone number with the phone number of the phone brought into the U.S. (col. 2, lines 22-55 and col. 4, lines 14-27). But, Houde et al. fail to explicitly show the method comprising: e) means for forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S.

However, Huotari teaches means for forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S. (col. 4, lines 52-64). Since, Houde et al. and Huotari are related to wireless telecommunication service; therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Houde et al. by specifically having means for forwarding calls to the non-U.S. phone number to the phone number of the phone brought into the U.S. as taught by Huotari for purpose of enhancing the quality of wireless telecommunication service.

Allowable Subject Matter

Claims 10, 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Lee (US-6,006,094) discloses method for routing an international call.
- b) Hammer et al. (US-2003/0166403) disclose international Temporary Local Directory Number Translaor.
- c) Laster (US-6,308,070) discloses remote origination of telephone calls.
- d) Dennis (US-6,542,733) discloses telephone dialing capabilities.
- e) Rogers (US-6,360,108) discloses automatic prepending of digits in a wireless communication device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 703-305-9007. The examiner can normally be reached on 8AM-5PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Urban F Edward can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phan, Huy Q

AU: 2685

Date : May 27, 2004


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